



## Facsimile

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Date: August 17, 2005  
Subject: 09/903,500 (F-278)  
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### CERTIFICATION OF FACSIMILE TRANSMISSION

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1. Appeal Brief Transmittal for Application No. 09/903,500 (F-278) (1 page)
2. Appeal Brief for Application No. 09/903,500 (F-278) (17 pages).
3. Copy of Prior Board Decision, Appeal No. 2003-2167, dated July 14, 2004 (11 pages).

on August 17, 2005  
Date of Transmission

A handwritten signature in black ink, appearing to read "Marlene Massop".

Marlene Massop  
Name

August 17, 2005  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

) Attorney Docket No.: F-278

John Eckl

) Group Art Unit: 3622

Serial No.: 09/903,500

) Examiner: Myhre, James W.

Filed: July 12, 2001

) Date: August 17, 2005

Title: BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION

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**TRANSMITTAL OF APPEAL BRIEF**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Transmitted herewith is the **APPEAL BRIEF** in the above-identified patent application with respect to the Notice of Appeal filed on March 14, 2005. This Appeal Brief is in response to a Notification of Non-Compliance. No fee is believed to be due because the filing fee of \$500 was paid on May 17, 2005 for the original Appeal Brief filed May 12, 2005. The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. 16-1885.

Respectfully submitted,

  
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 Name

August 17, 2005  
 Date

Serial No.: 09/903,500

Attorney Docket No.: F-278

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Patent application of: ) Attorney Docket No.: F-278  
John K. Eckl ) Group Art No.: 3622  
Filed: July 12, 2001 ) Customer No.: 00919  
Serial No.: 09/903,500 ) Examiner: Myhre, J. W.  
Confirmation No.: 5429 ) Date: August 17, 2005

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Title: **BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION**

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Alexandria, VA 22313-1450

**APPELLANT'S BRIEF ON APPEAL**

Sir:

In response to the Notification of Non-Compliant Appeal Brief dated July 20, 2005, Applicant respectfully submits this corrected copy of the Appeal Brief originally submitted May 12, 2005 for the subject application.

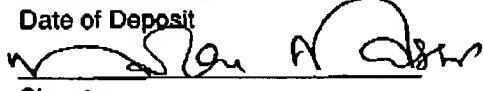
The Notice of Appeal was filed on March 14, 2005, following a Final Office Action mailed December 14, 2004.

**CERTIFICATE OF FACSIMILE**

I hereby certify that this correspondence is being faxed to the United States Patent and Trademark Office, to fax no.: (571) 273-8300, Attn.: Examiner, J. W. Myhre.

on August 17, 2005

Date of Deposit



Signature

Marlene Massop

Name

August 17, 2005

Date

Serial No.: 09/903,500

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**I.       Real Party in Interest**

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

**II.       Related Appeals and Interferences**

This application was the subject of a previous appeal, for which a previous appeal decision was made on July 14, 2004. A copy of this eleven page opinion is attached as Exhibit B. Rather than further appeal the Board's decision to affirm the rejections, Appellant opted to file an RCE to make clarifications to eliminate issues highlighted by the Board's choice of representative claim.

Some related issues were under appeal in application 09/289,901 titled ROUTER INSTRUCTION PROCESSOR FOR A DIGITAL DOCUMENT DELIVERY SYSTEM (Attorney Docket E-817), now issued as U.S. Patent 6,829,591 on December 7, 2004.

**III.       Status of Claims**

- (1)      Claims 1 and 11 and 13 are cancelled.
- (2)      Claims 12 and 14-36 are the subject of this Appeal, and stand rejected.
- (3)      Appellants hereby appeal the rejection of claims 12 and 14-36.

**IV.       Status of Amendments**

- (1)      The present application is based on an RCE filed on September 10, 2004 with amendments. This RCE and amendment were filed subsequent to a negative

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decision before the Board of Patent Appeals and Interferences. The amendments were made to claims 12, 18 and 19 to more clearly include the disputed features in the representative claims.

This application is also a continuation filed July 12, 2001 of application 08/772,293 filed December 23, 1996. A preliminary amendment was filed with the continuation canceling all of the original eleven claims and adding new claims 12-36. In response to a February 7, 2002 Office Action, applicants canceled claim 13 and amended claims 12, 16, 18, and 27-29.

- 2) Appendix A, attached hereto, contains current claims 12 and 14-36.

#### V. Summary of Claimed Subject Matter

The following description applies to the subject matter of independent claims 12, 18, 21, 26, and 30 under appeal. For purposes of this Appeal, the steps and elements relating to utilization of recipient delivery preferences in processing of billing statements is at the center of the dispute.

The appealed claims are directed to a method and apparatus for delivering billing statements from a biller to a recipient by means of a printed or electronic transmission. (Page 2, lines 1-3). The method of transmission is determined based on the preferences of the recipient. (Page 4, lines 2-16). In one embodiment, a billing server receives billing information from the biller's computer. (Page 3, lines 12-23). Based on the stored recipient preferences, the billing server determines whether the billing information is intended for printed or electronic transmission. (Page 4, 2-20). A printer is connected to the billing server to generate a printed billing statement from the billing information. (Page 3, lines 12-18).

An electronic information server is also connected to said billing server. The electronic information server converts billing information so that it is suitable for electronic transmission and generates electronic billing statements from the billing information. (Page 4, lines 13-16). The electronic information server electronically

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transmits the electronic billing statement to the recipient over a communications network. (Page 4, lines 13-27).

To properly direct the billing information for either printed or electronic delivery, a routing means coupled to the billing server routes the billing information to the printer if the billing statement is determined to be transmitted by printed transmission. (Page 3, lines 19-25). Similarly, billing information is routed to the electronic information server if the billing statement is determined to be transmitted by said electronic transmission. (*Id.*) For determining routing of billing information, a lookup table is coupled to said billing server. (Page 4, lines 2-17). The lookup table contains delivery preferences of bill recipients. (*Id.*) The routing means routes the billing information in accordance with stored delivery preferences. (Page 3, lines 19-25).

This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

## VI. Grounds of Rejection to be Reviewed on Appeal

Claims 12, 14, 15, 17-23, 25-27, 29-34, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,802,498 to Comesanas ("Comesanas"). Claims 16, 24, 28, and 35 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Comesanas in view of U.S. Patent 5,699,528 to Hogan ("Hogan").

## VII. Argument

### A. *The Board's Prior Decision*

In its prior decision the Board stated, "In our view, the teachings of Comesanas, taken as a whole, instructs an artisan that the debtor/customer chooses the delivery manner from the choices provided by the biller." Appellant submits that this conclusion

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is erroneous, and is not supported by the text of Comesanas. There is no teaching or suggestion in Comesanas that the debtor/customer ever has a choice in delivery method. The only teaching in that reference is that, for the delivery methods available, the biller chooses the delivery method. The only choice taught in that reference for the debtor/customer is whether to participate in a program for pre-payment of delivery charges.

After the Board's adverse decision, Appellant was then weighing its options for reconsideration, or for further appeals. The Board had chosen claim 18 as the representative claim. Of all the independent claims, the language of claim 18 was least explicit about the requirement that the delivery method be "in accordance with recipient preferences," and that delivery preferences were "recipient delivery preferences." Thus, rather than risk a further negative result because of a claim that did not adequately describe the disputed feature, an RCE and corrective amendment was filed. The Board's careful reconsideration is requested in view of amended claims that more clearly recite the requirement of choice of delivery based on "recipient delivery preferences."

To establish a proper case of obviousness under § 103(a), the Examiner must make a *prima facie* showing that the prior art contains some teaching or suggestion of, or motivation for, all the elements of the claimed invention. Thus, it is well settled that the Examiner "bears the initial burden ... of presenting a *prima facie* case of unpatentability." In re Piasecki, 223 USPQ 785, 788 (Fed. Cir. 1984); In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Riickaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

#### B. *Rejections based solely on Comesanas*

Because the prior art of record fails to show, and the Examiner failed to treat all the features of the appealed claims, the rejections of the claims was improper. In particular, the asserted references do not discloses or suggest the features relating to "delivery preferences" as recited in each of the independent claims (12, 18, 21, 26, and

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30). The Examiner has misconstrued a feature described in Comesanas, whereby an invoice recipient chooses whether to authorize pre-payment of return transmittal charges, to read on a method and system utilizing recipient "delivery preferences" whether to receive billing statements by physical or electronic delivery means.

The relevant portions of the of the rejected independent claims read as follows:

Claim 12 - "a billing server coupled to a biller's computer operative . . . to determine whether said billing information is intended by the recipient for said printed transmission or said electronic transmission", "lookup table containing delivery preferences for the at least one recipient indicating whether a billing statement is to be transmitted by a said printed transmission or electronic transmission, said routing means routing billing information in accordance with said delivery preferences;"

Claim 18 - "prescribing recipient delivery preferences for said billing information" and "associating said recipient delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission;"

Claim 21 - "means for extracting from a database the prescribed delivery preference corresponding to each said isolated record" and "means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference;"

Claim 26 - "extracting from a database the prescribed delivery preference corresponding to each said isolated record" and "determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference."

Claim 30 - "a server coupled to said switch, said server comprising: means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon the prescribed delivery preference of the corresponding recipient; means for converting billing information to a format appropriate for electronic transmission and generating an electronic billing statement from the billing information."

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These missing claim elements relate to using the "recipient" prescribed "delivery preference" in order to select printed or electronic delivery techniques.

In contrast, Comesanas is directed towards a system by which a customer can pre-authorize return transmittal charges to be added to charges in an invoice. For example, upon such pre-authorization, a biller can include a pre-paid return envelope with a bill, and a charge for the return envelope will be included in the invoice. This pre-authorization feature of Comesanas fails to satisfy the "delivery preference" elements recited in the rejected independent claims because it has nothing to do with a delivery preference for electronic or printed delivery.

Applicant does not dispute that Comesanas identifies both mail and electronic transmittal as potential means of delivery for invoices. However, that reference includes no description or suggestion of a recipient preference as playing a part in determining which method of delivery is used. Rather, it is expressly taught that the creditor has the choice of delivery method: "it is contemplated for a creditor have [sic] the option to eliminate the step of printing a paper copy of the invoice when the invoice information is electronically transmitted to the debtor." Col. 3, lines 6-10.

In describing an alternative to pre-paid return envelopes, Comesanas states:

[I]n the future, it is contemplated for transmittal of invoices and invoice payments to be accomplished electronically and for the existence of transmittal charges for such electronic transmittal. The present invention can be used in an *all-electronic* business environment whereby, for the debtors convenience in being allowed to make return payments electronically, the debtor signs a print written agreement that he authorizes being billed on his or her invoice for electronic transmittal charges that would otherwise be incurred by the creditor for such electronic return payments for which the creditor would be unwilling to pay.

Col. 3, lines 13-24, emphasis added.

In Comesanas' description of electronic transmittal being an alternative to paper mail transmittal, there is no description or indication that invoice recipients have an opportunity to express preferences of whether to receive bills by electronic or printed transmission. As a further result, there is no description or suggestion that such preferences be stored and acted upon as part of the processing of billing statements, as

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per the rejected independent claims. In Comesanas, an "all-electronic business environment" (Col. 3, line 17) is only generally described as an alternative to paper transactions. Recipient preferences for choosing between printed or electronic delivery are never mentioned or suggested.

To overcome these shortfalls, the Examiner's best argument is that Claim 3 of Comesanas, at Col. 4, lines 50-52, states the step of "determining whether each of said invoices is to be sent electronically or by mail." Other than the specification's speculation that electronic delivery might one day replace physical mail, this claim step is not discussed in the body of Comesanas. In particular, nowhere does Comesanas describe or suggest that such determining step is based on recipient preferences, or that such preferences be stored, retrieved, and acted upon, as recited in the rejected independent claims. The mere existence of two potential modes of transmittal does not disclose or suggest the specific steps and elements for utilizing recipient delivery preferences as recited in the rejected claims.

The Examiner (and prior Board decision) appear to rely on Comesanas' description of the debtor's choice of whether to authorize the pre-payment of transmittal charges, as satisfying the missing claim elements. For example, again in Claim 3 of Comesanas, at Col. 4, lines 44-47; a step of "determining whether each of said selected debtors has signed an agreement to pay transmittal charges for return payment and if such an agreement was signed," is recited. This determination in Comesanas has nothing to do with implementing a recipient's preference as to printed or electronic delivery, only whether transmittal charges for return payment is authorized. There is no indication anywhere in Comesanas that the debtor is allowed to express a preference of printed or electronic transmission.

A choice of transmission method and a choice of prepaid return transmittal charges are conceptually independent, and the availability of one does not necessitate the presence of the other. Any such suggestion of a connection by the Examiner is not supported and is constructed wholly from impermissible hindsight in view of the now apparent merits of Applicant's invention.

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Accordingly, it is respectfully submitted that the rejections of independent claims 12, 18, 21, 26, and 30 and their respective dependent claims in view of Comesanas should be overturned.

**B. Rejections Based on Comesanas in View of Hogan**

Claims 16, 24, 28, and 35 stand rejected as being unpatentable over Comesanas in view of Hogan. As discussed above, the claims of the present application recite the selection of printed or electronic transmittal based on prescribed customer preferences, a feature not described or suggested by Comesanas.

Hogan describes an electronic billing system including various features, but that fails to describe or suggest the features noted above as missing from Comesanas. In particular, Hogan does not include recipient preferences for printed or electronic delivery. The Examiner does not assert that Hogan includes the missing features identified above, but cites that reference in relation to claim elements that are not part of this appeal. Accordingly, Hogan does not cure the defects of Comesanas described above and claims 16, 24, 28, and 35 should be allowable for the same reasons.

**Official Notices**

For certain dependent claims, the Examiner has relied on statements of Official Notice for disclosure of certain steps and elements. Because Appellant has decided that this Appeal will stand or fall based on elements missing from the independent claims, those arguments are not presently pertinent. However, Appellant does not concede that the Examiner's statements of Official Notice, even if true by themselves, are sufficient to meet the requirements for anticipating the claim element or for combination with the other elements.

For example, one Official Notice states that "it is old and well known within the database art to place use [sic] a table format to save memory space when storing such data." Such Official Notice is insufficient, however, for providing a disclosure or suggestion that information to be stored is delivery preferences, or for combining a particular memory technique with other elements. Other such Official Notices are not to

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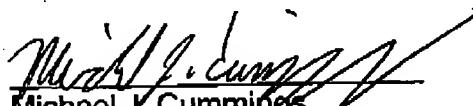
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the point for which they are asserted. As such, Appellant reserves all rights to unargued claim elements, particularly in the dependent claims.

### VIII. Conclusion

For the reasons advanced above, the Appellant respectfully submits that claim 12 and 14-36 are patentable. Reversals of the rejections by the Examiner are respectfully solicited.

Respectfully submitted,



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10/17

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**APPENDIX A****BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION****Current Copy of the Claims**

1-11. (Cancelled)

12. A billing system for delivering billing statements from a biller to a recipient by means of a printed transmission or electronic transmission, comprising:

a billing server coupled to a biller's computer operative to receive billing information from said biller's computer and to determine whether said billing information is intended by the recipient for said printed transmission or said electronic transmission;

a printer operably connected to said server operative to generate a printed billing statement from said billing information;

an electronic information server operably connected to said billing server, said electronic information server operative to convert said billing information for electronic transmission and generate an electronic billing statement from said billing information and electronically transmit the electronic billing statement to the at least one recipient over a communications network;

routing means coupled to said billing server for routing said billing information to said printer if said billing statement is determined to be transmitted by said printed transmission and to said electronic information server if said billing statement is determined to be transmitted by said electronic transmission; and

a lookup table coupled to said billing server, said lookup table containing delivery preferences for the at least one recipient indicating whether a billing statement is to be transmitted by a said printed transmission or electronic transmission, said routing means routing billing information in accordance with said delivery preferences.

13. (Cancelled)

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14. A billing system as recited in claim 12 wherein the biller's computer contains billing information for a plurality of recipients and the billing server includes means for separating billing information corresponding to individual recipients.

15. A billing system as recited in claim 12 further including an inserter system coupled to said printer.

16. A billing system as recited in claim 12 wherein the electronic information server includes means for determining whether or not a said recipient has retrieved a transmitted electronic billing statement.

17. A billing system as recited in claim 12 further including means for electronically transmitting funds from said at least one recipient to said biller.

18. A method for delivering billing statements from a biller to a recipient, in accordance with recipient preferences, by means of a printed transmission or electronic transmission, comprising the steps of:

generate billing information for at least one recipient from a biller's computer;  
prescribing recipient delivery preferences for said billing information;  
associating said recipient delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission;

generating a printed billing statement from said billing information if said billing information was determined to be transmitted via printed transmission;

converting said billing information for electronic transmission if said billing information was determined to be transmitted via electronic transmission; and

generating an electronic billing statement from said converted billing information if said billing information was determined to be transmitted via electronic transmission.

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19. A method for delivering billing statements as recited in claim 18 further including the step of providing said recipient delivery preferences in a database separate from said biller's computer for generating said billing information.

20. A method for delivering billing statements as recited in claim 18 further including the step of electronically transmitting funds from said at least one recipient to said biller.

21. In a billing system having a computer operative to generate billing information for a plurality of recipients and to communicate said billing information to a printer operative to generate printed billing statements from said billing information, an apparatus for delivering billing statements to the plurality of recipients by one of printed transmission or electronic transmission based upon a prescribed delivery preference of each said recipient, comprising:

means for accessing said billing information prior to said billing information being communicated to said printer, said billing information comprising a plurality of records, each record corresponding to one of said recipients and each said record not containing the prescribed delivery preference of the corresponding recipient;

means for isolating each said record from said billing information;

means for extracting from a database the prescribed delivery preference corresponding to each said isolated record;

means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference;

means for converting billing information to a format appropriate for electronic transmission and generating an electronic billing statement from the billing information;

means for electronically transmitting said electronic billing statement to at least one of said recipients over a communications network; and

means for routing to said printer the records determined to be intended for printed transmission and to said converting and generating means the records determined to be intended for electronic transmission.

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22. An apparatus according to claim 21, wherein said prescribed delivery preferences are stored in said database prior to the generation of said billing information.

23. An apparatus according to claim 21, further comprising an inserter system coupled to said printer.

24. An apparatus according to claim 21, further comprising means for determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

25. An apparatus according to claim 21, further comprising means for electronically transmitting funds from said recipients to a biller for whom said billing information is generated.

26. In a billing system having a computer operative to generate billing information for a plurality of recipients and to communicate said billing information to a printer operative to generate printed billing statements from said billing information, a method for delivering billing statements to the plurality of recipients by one of printed transmission or electronic transmission based upon a prescribed delivery preference of each said recipient, comprising:

accessing said billing information prior to said billing information being communicated to said printer, said billing information comprising a plurality of records, each record corresponding to one of said recipients and each said record not containing the prescribed delivery preference of the corresponding recipient;

isolating each said record from said billing information;

extracting from a database the prescribed delivery preference corresponding to each said isolated record;

determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference;

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converting the records determined to be intended for electronic transmission to a format appropriate for electronic transmission and generating an electronic billing statement from the converted records;

electronically transmitting said electronic billing statements to the corresponding recipients over a communications network; and

routing to said printer the records determined to be intended for printed transmission.

27. A method according to claim 26, further comprising storing the prescribed delivery preferences in said database prior to the generation of said billing information.

28. A method according to claim 26, further comprising determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

29. A method according to claim 26, further comprising electronically transmitting funds from said recipients to a biller for whom said billing information is generated.

30. In a billing system having a computer operative to generate billing information for a plurality of recipients and to communicate said billing information to a printer operative to generate printed billing statements from said billing information, an apparatus for delivering billing statements to the plurality of recipients by one of printed transmission or electronic transmission based upon a prescribed delivery preference of each said recipient, comprising:

a switch for accessing said billing information prior to said billing information being communicated to said printer, said billing information comprising a plurality of records, each record corresponding to one of said recipients; and

a server coupled to said switch, said server comprising:

means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon the prescribed delivery preference of the corresponding recipient;

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means for converting billing information to a format appropriate for electronic transmission and generating an electronic billing statement from the billing information;

means for electronically transmitting said electronic billing statement to at least one of said recipients over a communications network; and

means for routing to said printer the records determined to be intended for printed transmission and to said converting and generating means the records determined to be intended for electronic transmission;

wherein said switch routes all of said records to said printer if said server fails or is taken out of service.

31. An apparatus according to claim 30, said server further comprising means for isolating each said record from said billing information.

32. An apparatus according to claim 31, said server further comprising means for extracting from a database the prescribed delivery preference corresponding to each said isolated record.

33. An apparatus according to claim 31, said server further comprising means for sanitizing each of said records.

34. An apparatus according to claim 30, further comprising an inserter system coupled to said printer.

35. An apparatus according to claim 30, said server further comprising means for determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

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The opinion in support of the decision being entered today was not written  
for publication and is not binding precedent of the Board.

AUG 17 2005

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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JUL 14 2004

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JOHN K. ECKL

F-278

Appeal No. 2003-2167  
Application No. 09/903,500

ON BRIEF

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JUL 19 2004

HITNEY BOWES  
INTELLECTUAL PROPERTY  
& TECHNOLOGY LAW DEPT.

Before FRANKFORT, FLEMING, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 12 and 14 to 36, which are all of the claims pending in this application.

We AFFIRM.

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Appeal No. 2003-2167  
Application No. 09/903,500

BACKGROUND

The appellant's invention relates to envelope inserting equipment, and more particularly to such equipment which is utilized by production mailers to send bills or statements to their customers (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hogan	5,699,528	Dec. 16, 1997
Comesanas	5,802,498	Sept. 1, 1998

Claims 12, 14, 15, 17 to 23, 25 to 27, 29 to 34 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Comesanas.

Claims 16, 24, 28 and 35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Comesanas in view of Hogan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 12, mailed March 19, 2003) for the examiner's complete reasoning in

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support of the rejections, and to the brief (Paper No. 11, filed January 30, 2003) and reply brief (Paper No. 14, filed May 22, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

In the Grouping of Claims section of the brief (p. 4), the appellant stated that Claims 12 and 14 to 36 stand and fall together. We have selected claim 18 as the representative claim from that grouping of claims.

Claim 18 reads as follows:

A method for delivering billing statements from a biller to a recipient by means of a printed transmission or electronic transmission, comprising the steps of:

generate billing information for at least one recipient from a biller's computer;

prescribing delivery preferences for said billing information;

associating said delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission;

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generating a printed billing statement from said billing information if said billing information was determined to be transmitted via printed transmission; converting said billing information for electronic transmission if said billing information was determined to be transmitted via electronic transmission; and generating an electronic billing statement from said converted billing information if said billing information was determined to be transmitted via electronic transmission.

Comesanas' invention relates to computer programs, specifically to computer software which directs the printing of customer invoices to include current billing information and transmittal charges for a pre-paid return envelope which the customer will receive with the invoice for use in return of the invoice payment and which also directs collation or assembly of the pre-paid return envelope, the invoice, and the shipping envelope in which the invoice and pre-paid return envelope will be sent to the customer.

As shown in Figures 1-2, Comesanas' invention provides an automated, computer-directed means by which banking institutions and credit card companies may attempt to expedite the return of invoice payments. At the same time Comesanas' invention provides a service for customers by providing the customer with a time saving pre-paid envelope for return of an invoice payment. In the preferred embodiment, after the computer software billing system is properly loaded into the computer memory and executed, the computer would access a database containing debtor account

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information. Then after reviewing information presented for the first debtor account, the computer would decide whether a payment was required for that debtor, and, if so, generate an invoice for the first debtor account so that the creditor's address is in a consolidated position on the invoice for use with a return envelope having a window and so that the debtor's current address is also in a consolidated position on the invoice for use with a shipping envelope having a window. The computer would then determine from the information in the database whether or not the first debtor has signed an agreement to pay transmittal charges associated with a return envelope. If the debtor has signed such an agreement, the transmittal charges would be added to the invoice. The computer would then direct a printer to print an invoice for the first debtor.

Comesanas teaches (column 3, lines 5-45) that:

In a second embodiment of the present invention (not shown), it is contemplated for a creditor have the option to eliminate the step of printing a paper copy of the invoice when the invoice information is electronically transmitted to the debtor.

Transmittal of the invoice to each debtor is contemplated in two ways. In today's business environment a shipping envelope is routinely required. However, in the future, it is contemplated for transmittal of invoices and invoice payments to be accomplished electronically and for the existence of transmittal charges for such electronic transmittal. The present invention can be used in an all-electronic business environment whereby, for the debtor's convenience in being allowed to make return payments electronically, the debtor signs a print written agreement that he authorizes being billed on his or her invoice for electronic transmittal charges that would otherwise be incurred by the creditor for such electronic return payment and for which the creditor would be unwilling to pay. Should envelopes be required, the computer will determine whether an address is needed for either the shipping envelope or the pre-paid return envelope. If addresses are required, the computer will direct a printer to print the creditor's address on the pre-paid return envelope and the debtor's current

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address on the shipping envelope. It is not critical to the present invention which envelope is printed first. The computer will then direct a postage metering device to print transmittal charges onto the shipping envelope and onto the return envelope as needed. Again, it is not critical to the present invention which envelope is printed first. The computer-aided billing system will then have the computer direct the collation or assembly of the pre-paid return envelope, the shipping envelope, and the invoice for transmittal to the customer. This process is repeated for each successive debtor in the database. As the operating speeds of printers and postage metering devices are variable, the order of the steps included herein may be varied to the extent necessary to maximize the efficiency of each printer and each postage metering device used by a creditor without departing from the fundamental intent of the present invention.

Claims 3 and 4 of Comesanas read as follows:

3. A computer program comprising the steps of directing a computer to access a database containing debtor account information; directing said computer to read said debtor account information for each successive debtor in said database; compiling current billing information from said debtor account information for selected ones of said debtors from whom a payment is required so as to generate an invoice for each of said selected debtors; determining whether each of said selected debtors has signed an agreement to pay transmittal charges for return payment and if such an agreement was signed, directing said computer to compile said transmittal charges for said return payment into the ones of said invoices generated for each of said selected debtors who had signed such an agreement; determining whether each of said invoices is to be sent electronically or by mail, and if by mail directing a printer to print a paper copy of each of said invoices to be sent by mail; directing said printer to address a return envelope with the address of each of said selected debtors who has signed an agreement to pay transmittal charges for return payment, and further directing the collation of an invoices a shipping envelope, and a prepaid return envelope for each of said selected debtors who has signed an agreement to pay transmittal charges for return payment by mail so that said current billing information in said invoices can be transmitted to each of said selected debtors in said database from whom a payment is required.

4. The computer program of claim 3 wherein said step of determining whether each of said selected debtors has signed an agreement to pay

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transmittal charges for return payment comprises the step of determining whether said return payment is to be made electronically, and if so directing said computer to compile said transmittal charges for said electronic return payment into the ones of said invoices generated for each of said selected debtors who had signed such an agreement.

In the rejection of claim 18 under 35 U.S.C. § 103 (answer, pp. 3-5), the examiner implicitly ascertained that Comesanas, either expressly or inherently described, every limitation of claim 18 except for the steps of (1) converting the billing information for electronic transmission if the billing information was determined to be transmitted via electronic transmission; and (2) generating an electronic billing statement from the converted billing information if the billing information was determined to be transmitted via electronic transmission.

With regard to these differences, the examiner (answer, p. 5) took Official Notice that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer and then concluded that "it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas' system was being converted to the proper format for printing or electronic transmission." Implicit in this rejection is the examiner's view that

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the above noted modification of Comesanas would result in a method which corresponds to the method recited in claim 18 in all respects.

The appellant does not dispute the obviousness of the above-noted modification of Comesanas, however, the appellant does argue throughout both briefs that such a modification of Comesanas would not result in a method which corresponds to the method recited in claim 18 in all respects. Specifically, the appellant argues that Comesanas does not teach or suggest "prescribing delivery preferences for said billing information" and "associating said delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission." We do not agree.

In our view, the teachings of Comesanas, taken as a whole, instructs an artisan that the debtor/customer chooses the delivery manner from the choices provided by the biller. In this instance, Comesanas teaches that the biller provides three choices for delivery of the invoice as follows: (1) by mail without a pre-paid envelope; (2) by mail with a pre-paid envelope with the invoice reflecting the cost of the pre-paid envelope; and (3) by electronic transmission with the invoice reflecting the transmittal charges of the electronic transmission. Comesanas then teaches that the biller utilizes the selected delivery choice for transmitting the invoice to the debtor/customer. As such,

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Comesanas does teach and suggest "prescribing delivery preferences for said billing information" and "associating said delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission."

For the reasons set forth above, the decision of the examiner to reject claim 18 under 35 U.S.C. § 103 is affirmed.

The decision of the examiner to reject claims 12, 14 to 17 and 19 to 36 under 35 U.S.C. § 103 is also affirmed since the appellant, as noted above, has grouped claims 12 and 14 to 36 as standing and falling together and has not argued separately the patentability of any particular claim apart from the others. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); and 37 CFR § 1.192(c)(7) and (8)(iv)).

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 12 and 14 to 36 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

AFFIRMED

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CHARLES E. FRANKFORT  
Administrative Patent Judge

*Michael R. Fleming*  
MICHAEL R. FLEMING  
Administrative Patent Judge

*Jeffrey V. Nase*  
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